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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/416,675	10/12/1999	ERIC ROBINSON	C013-1002	6451

7590 12/16/2002  
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EXAMINER

LE, UYEN T

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 21

Application Number: 09/416,675  
Filing Date: October 12, 1999  
Appellant(s): ROBINSON, ERIC

William G. Lane  
For Appellant

**MAILED**  
DEC 1 8 2002  
Technology Center 2100

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 October 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 21-40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5,758,067	MAKINEN et al	5-1998
5,887,145	HARARI et al	3-1999

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-40 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in prior Office Action, Paper No.10, hereby repeated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makinen et al (US 5,758,067) of record, provided by the applicant, in view of Harari et al (US 5,887,145) of record.

Regarding claim 21, Makinen discloses a method of automatically backing up data from a computer (see the abstract). Although Makinen does not specifically show that the automatic backup system (ABS) is connected to the PCMCIA port of the computer, it is well known in the art as shown by Harari to connect peripheral cards to the PCMCIA port on a computer for backup purposes (see column 3, lines 20-23, column 9, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art to include connecting a ABS unit to the PCMCIA port while implementing the method taught by Makinen in order to use a standard port of the computer to attach

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peripheral cards for automatic backup of data as taught by Makinen. Furthermore, it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning for devices connected to the PCMCIA port, recognizing the ABS unit inserted to the PCMCIA port, launching the automatic backup procedure, scanning all source files and comparing to the files on the ABS for changes, determining space required for backing up data and space available on the ABS, making a file-by-file transfer of the changes to the ABS unit if space is available on the ABS since the computer has to recognize the presence of the ABS before launching the automatic backup and only files that have changed need be backed up again on the ABS, provided space is available on the ABS.

Regarding claim 22, official notice is taken that it is well known in the art for a computer to report the status of an operation. Therefore, it would have been obvious to one of ordinary skill in the art to make the computer report status of backup at the end of the file-by-file transfer to the ABS in order to allow users to verify the status of the files being backed up.

Regarding claims 23, 24, although Makinen does not specifically show that the computer writes the status of the file-by-file transfer to the ABS unit at the end of backup to the source drives and reviews the status of the file-by-file transfer when it scans all files on the source drives and compares the files on the ABS unit for data and time changes, it would have been obvious to one of ordinary skill in the art to do so in order to keep track of which files have been last backed up at the ABS unit.

Regarding claim 25, it would have been obvious to one of ordinary skill in the art to make the computer terminate the backup after completion of writing the status of the file-by-file transfer to the ABS in order to complete the operation of backup and turn off the ABS unit.

Regarding claim 26, it would have been obvious to one of ordinary skill in the art to make the computer offer an operator a manual option to launch backup prior to the computer scanning all files on the source drive in order to allow the operator to control the operation of backup for specific files.

Regarding claim 27, it would have been obvious to one of ordinary skill in the art to make the computer automatically commence the backup procedure once the operator manually selects backup in order to automatically backing up the files selected by the operator.

Regarding claim 28, Maniken teaches an automatic backup system but fails to specifically show that the computer scans its registry for an automatic backup launch file when the computer recognizes the ABS unit connected to its PCMCIA port. However, it is well known in the art as shown by Harari to connect peripherals to the PCMCIA port of a computer to backup data as discussed in claim 1. Therefore, it would have been obvious to one of ordinary skill in the art to include scanning the computer registry for an automatic backup launch file upon recognition of the presence of an ABS unit in order to automatically launch the backup operation without operator intervention.

Regarding claim 29, since a password identifies who can access data, it would have been obvious to one of ordinary skill in the art to make the computer request a

password after connection of the ABS to the computer and to include all the claimed operations in order to prevent unauthorized operators to access and copy data from the computer or the ABS unit.

Regarding claim 30, since a correct password is needed for the ABS unit to operate, it would have been obvious to one of ordinary skill in the art to make the computer request a password, translate the password from its registry, transfer the password to the ABS unit connected to its PCMCIA port in order to authenticate users.

Regarding claim 31, since data should be protected from unauthorized access, it would have been obvious to one of ordinary skill in the art to include all the claimed operations while implementing the method of Maniken and Harari in order to prevent unauthorized access to data.

Regarding claim 32, it would have been obvious to one of ordinary skill in the art to include requesting the operator for a selection of options after the computer recognizes the ABS unit connected to its PCMCIA port and before launching the backup procedure in order to give more flexibility to the operators who desire specific features.

Claim 33 merely reads on the fact that any application has to operate according to its configuration. Therefore, it would have been obvious to one of ordinary skill in the art to make the computer scan its registry for options selections prior to launching the backup procedure in order for the operation to perform according to the desired options set by an operator.

Regarding claim 34, since the backup system is external to the computer as shown by Hariki, it would have been obvious to one of ordinary skill in the art to make

the computer request removal of the ABS unit from its PCMCIA port once the operation is completed in order to disconnect the ABS unit from the computer.

Regarding claim 35, it would have been obvious to one of ordinary skill in the art to make the computer request insertion of the ABS unit to the computer PCMCIA port in order to perform the backup operation.

Claim 36 merely reads on the fact that the computer detects the absence of the ABS unit during backup operation and requests reconnection. It would have been obvious to one of ordinary skill in the art to include the claimed operations in order to complete an ongoing backup process.

Claims 37, 38 merely read on the fact that enough space should be detected prior to launching a backup operation. Therefore, it would have been obvious to one of ordinary skill in the art to make the computer compare the space available on the ABS unit to the file changes and to replace the ABS which has insufficient space with one having enough space to backup the source drives in order to avoid wasting time on an incomplete operation due to insufficient space on the ABS unit.

Regarding claim 39, since enough space is necessary to backup changed data, it would have been obvious to one of ordinary skill in the art to make the computer shut down the backup procedure when it finds there is insufficient available space to complete the backup procedure in order to avoid wasting time on an incomplete backup due to insufficient space.

Regarding claim 40, Makinen discloses an automatic backup system (see the abstract). Although Makinen does not specifically show that the system performs all the



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claimed operations, it is well known in the art to connect a backup system to a computer as shown by Harari (see column 3, lines 20-23, column 9, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning and detecting a device connected to a port of the computer, identifying the automatic backup system, automatically launching a backup procedure while implementing the system of Makinen in order to backup file changes to a system connected to the computer through a port depending on the size of the backup data as taught by Harari to avoid operator's intervention. Furthermore, since the backup system is inserted to a port of the computer, it would have been obvious to one of ordinary skill in the art to make the computer automatically close the backup procedure once the backup has been complete in order to disconnect the backup system from the computer system.

**(11) *Response to Argument***

Regarding claim 21, appellant alleges that Makinen does not disclose a method of automatically backing up data from a computer and that Makinen requires a scheduler for backup.

In response, claim 21 does not exclude the use of a scheduler to perform an automatic backup. Claim 21 is broad enough to read on the method of scheduled automatic backup disclosed by Maniken. Makinen explicitly shows that the method automatically performs data backup (see column 1, lines 55-62, columns 2-4).

Appellant further argues at page 7, last paragraph that Makinen does not teach the combination of steps of claim 21 and in particular does not suggest or teach

“recognizing the ABS unit inserted into the PCMCIA port, launching the automatic backup procedure...”.

In response, appellant attacks a reference individually in a 103 rejection. The combination of steps of claim 21 is clearly taught by Makinen and Harari.

Appellant further argues at page 9, second paragraph that Harari fails to teach launching the automatic backup procedure upon recognition of the ABS unit inserted into the PCMCIA port.

In response, again, appellant attacks a reference individually in a 103 rejection. Harari was cited merely to show that it is well known to use the PCMCIA port to insert peripherals for backup purpose. Furthermore, before the automatic backup procedure is launched, clearly the system of Makinen has to recognize all hardware necessary to the backup operation. The motivation to combine the teachings of Makinen and Harari was clearly stated in the Office Action. One of ordinary skill in the art presumably knows something about the art besides what is explicitly disclosed by a reference and knows how to apply the principles taught by the references to get the desired results.

Regarding claim 22, appellant argues that the examiner cited no prior art teaching reporting the status of an operation and that the examiner relied upon hindsight to arrive at the determination of obviousness. Note that appellant repeats the argument that the examiner is using hindsight for claims 26-40. The response to this argument applies to all of those claims.

In response to the argument that no prior art was cited to teach the reporting feature, the examiner took official notice that it is well known in the art to report the

status of an operation. Furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Regarding claims 23, 24, appellant argues that neither Makinen or Harari teach or even suggest the steps of claims 23 and 24.

In response, the references do not have to teach or suggest each step claimed by the appellant. One of ordinary skill in the art presumably knows something about the art besides of what is explicitly shown or suggested in the references and knows how to apply the principles taught in the combination of the references to arrive at a desired result.

With specific reference to claim 25, appellant argues that the examiner's statement is not supported by evidence of a teaching, suggestion or motivation.

Again, the references do not have to teach or suggest the claimed features. Claim 25 merely requires that the computer terminates the backup after completion of writing the status of the file-by-file transfer to the ABS unit at the completion of the backup. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 26, appellant again argues that the examiner is using hindsight and that there is no teaching, suggestion or motivation.

In response, claim 26 merely requires the computer to offer an operator the option to manually launch backup prior to the computer scanning all files on the source drive. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated by the examiner in the Office Action.

With specific reference to claim 27, appellant repeats the argument that the examiner is using hindsight and there is no teaching, suggestion or motivation.

In response, claim 27 merely requires the operator to manually select the backup and the computer to automatically commence the backup procedure. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 28, applicant repeats the argument that the examiner is using hindsight and there is no teaching, suggestion or motivation.

In response, claim 28 merely requires scanning the registry for an automatic backup launch file when the computer recognizes the ABS unit connected to its PCMCIA port. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 29, appellant argues that the use of password is old but the combination of claim 29 is new. Appellant also repeats the argument that the examiner is using hindsight.

In response, claim 29 in essence merely requires the use of a password in combination with the backup operation. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 30, appellant repeats the argument that the examiner is using hindsight and there is no teaching, suggestion or motivation.

In response, the motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 31, appellant presents no argument.

With specific reference to claim 32, appellant argues that there is no evidence showing motivation to combine and modify to yield claim 32. Appellant also repeats the argument that the examiner is using hindsight.

In response, the motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action. Again one of ordinary skill in the art presumably knows something about the art apart what is explicitly disclosed by a reference and knows how to apply the principles taught by the references to get the desired results.

With specific reference to claim 33, appellant argues that the claimed step is not taught by either of the cited reference. Appellant also repeats the argument that the examiner is using hindsight.

In response, claim 33 merely reads on the fact that any application has to operate according to its configuration. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 34, appellant argues that the claim does not limit the step to "once the operation is complete". Appellant also repeats the argument that the examiner is using hindsight.

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In response, claim 34 merely requires the computer to request removal of the ABS unit from its PCMCIA port. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action. "Once the operation is complete" was simply given by the examiner as a scenario where the ABS unit is no longer needed.

With specific reference to claim 35, appellant argues that the claimed step is not taught, suggested or motivated by the references. Appellant also repeats the argument that the examiner is using hindsight.

In response, claim 35 merely requires the computer to request insertion of the ABS unit to its PCMCIA port. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 36, appellant argues that the claimed step is not taught, suggested or motivated by the references. Appellant also repeats the argument that the examiner is using hindsight.

In response, claim 36 merely reads on the fact that the computer detects the absence of the ABS unit during backup operation and requests reconnection. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claims 37, 38, appellant argues that the claimed steps are not taught, suggested or motivated by the references. Appellant also repeats the argument that the examiner is using hindsight.

In response, Claims 37, 38 merely read on the fact that enough space should be detected prior to launching a backup operation. The motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 39, appellant argues that the additional steps are not taught, suggested or motivated by the references. Appellant also repeats the argument that the examiner is using hindsight.

In response, the motivation for one of ordinary skill in the art to include the claimed feature was clearly stated in the Office Action.

With specific reference to claim 40, appellant argues that the automatic backup taught by Makinen does not commence unless the scheduled date and time was met.

In response, claim 40 does not exclude scheduled automatic backup. Claim 40 is broad enough to read on the scheduled automatic backup of Makinen.

Appellant further argues that Makinen and Harari do not show that the system perform all the claimed operations and that neither reference teaches or suggests automatically launching a backup procedure without human intervention. Appellant again seems to argue each reference separately. Appellant also repeats the argument that the examiner is using hindsight.

In response, Maniken discloses an automatic backup system (see the abstract). Harari shows that it is well known in the art to connect a backup system to a computer (see column 3, lines 20-23, column 9, lines 18-30). Claim 40 was rejected under 35 U.S.C. 103(a) as being unpatentable over Makinen in view of Harari. Each reference does not have to teach all the limitations of claim 40. One of ordinary skill in the art

having both Makinen and Harari reference would certainly be motivated to combine the teachings as stated in the Office Action.

Regarding the drawings submitted on 12, March 2002, because the drawings are not legible, they have not been approved.

Appellant filed an amendment after receipt of the final Office Action. That amendment had not been entered because it changed the scope of the claims, thus would require further consideration and search.

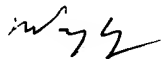
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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December 16, 2002

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